

REMARKS

Applicants present this Amendment and respectfully request reconsideration followed by allowance.

Applicants' counsel acknowledges the Examiner's courtesies during telephone discussions had on September 2, 2003 and September 3, 2003 concerning the Supplemental Amendment filed herein on June 4, 2003.

The amendments to the claims assume the PTO matched the June 4, 2003 Amendment with this application file. It is considered that the present claims find support in the originally filed application.

The new claims find basis in the specification throughout, including the original claims. The Examiner may wish to consider page 6, lines 13-10, page 10, lines 8-14, page 11, lines 1-2, and pages 14-14.

The Examiner objected to "may" in claims 5 and 6 as indefinite. The objection to claims 5 and 6 is not understood. As the Board of Appeals said in Ex parte Wu, 10 USPQ2d (BNA) 2031, 2033 (BOPI 1989), "[i]n rejecting a claim under the second paragraph of 35 USC 112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. In re Moore, 169 USPQ (BNA) 236 (CCPA 1971); In re Hammack, 166 USPQ (BNA) 204 (CCPA 1970)." Clearly the word "may" is not indefinite. For instance, even a search of the PTO's own web site on September 3, 2003 revealed that **206,995** issued U.S. Patents contained the word 'may' in a claim or claims. Exhibit A hereto. Indeed, in the present context, the R₅ and R₆ groups in claim 5 or 6 may optionally contain a hetero atom, which is sufficiently lucid for a person skilled in the art. However, with the word "may" being deleted - as it's not essential to a lucid understanding

of the claim, the basis for the objection becomes moot without surrendering claim scope. Accordingly, the objection should be reconsidered and withdrawn.

Claim 12, as amended, deletes "part of weight." This does not narrow the claim scope. It is pointed out that 0.01 is not plural, hence "part by weight." See, e.g., specification at page 10, line 15 et seq. However, with the deletion, this objection is mooted in its entirety without affecting claim scope.

Claims 12 and 13, in context, refer to parts by weight with respect to the polyurethane. That would be understood by a person skilled in the art. See, e.g., specification at page 10, line 15 et seq. Please reconsider and withdraw this rejection.

Claim 7 was amended on June 4, 2003, and it is deemed sufficient to have addressed the objection under §112(¶1) to point out the amendment. The claim 7 preamble refers to "[a] process for producing a polyurethane composition having improved anti-leaching as to ingredients incorporated therein." The body of claim 7 recites "selecting said ingredients..." and "incorporating said ingredients in a polyurethane to obtain said polyurethane composition." The preamble is clearly part of the claimed invention as it provides antecedent basis for terms in the body of claim 7.

Consequently, it is also seen that the objection to claims 8 and 11-14, based on the objection to claim 7, should be reconsidered and withdrawn.

Applicants submit their claims define novel, unobvious inventions over the presently applied art.

The Examiner "bears the initial burden, on review of the prior art . . . , of presenting a *prima facie* case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A rejection cannot be predicated on the mere identification of individual components of claimed limitations. There must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select

the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998); see also In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "[I]t is incumbent upon the examiner to identify some suggestion to combine the references or make the modification." Ex parte Askman, Appeal No. 96-1548 (June 10, 1999) at page 5, quoting In re Mayne, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

It is respectfully submitted, for instance, that the rejection over the combination of JP 46-278874 in view of JP 57-108154 merits reconsideration and withdrawal. First, the primary reference does not teach a combination of an amide compound of Applicants' formula (I) in combination with a hindered phenol defined by formula (II) or formula (III). Second, the Office Action states that the "primary reference is silent regarding the use of hindered phenol compounds." Office Action, page 4. *See, e.g., Ex parte Browne*, 19 USPQ2d 1609, 1612 (BOPI 1990) ("since the prior art is silent as to this feature, we are unable to sustain the rejection which we originally precipitated."). Third, even if, *arguendo*, the combination of references would have been made, the fact remains that the JP-57-108154 reference ("JP '154") is silent regarding the hindered phenol compound and the amide compound. Consequently, it is not seen that there would have been a teaching to select the amide in particular, select the hindered phenol, or even make the combination as proposed in the Office Action.

It is respectfully submitted that the rejection over the combination of JP 46-278874 in view of Ishii (JP '744) merits reconsideration and withdrawal. First, the Office Action states that the "primary reference is silent regarding the use of hindered phenol compounds." Office Action, page 4. Second, the Ishii '744 reference discloses that "there were few stabilizers effective to prevent both yellowing due to sunlight and that due to nitrogen oxide gases." Ishii '744, column 1, lines 37-39. The Ishii '744 reference is rather specific in disclosing a specified "particular phenolic type compound," which can remarkably improve resistance to yellowing when used alone, but that the resistance can be improved when used in combination with "at least one member selected from benzotriazole type light stabilizers and hindered amine type ones..." Ishii '744, column 1, lines 43-50. Ishii et al. '744 refer to a

formula for a phenol compound but the R₁ is methyl, ethyl or propyl, with methyl being preferred (column 2, lines 11-15), which clearly would not have suggested the hindered phenol of claim 17 or claim 18. Even if, *arguendo*, the combination of references would have been made, the fact remains that the JP '874 is silent regarding the hindered phenol compound and its combination with a selection of one of the ingredients from the Ishii '744 reference finds basis in hindsight, not prior art. In addition, selecting one ingredient from combination in Ishii '744 suggests picking and choosing only that which would support the rejection, which is basis for reconsidering and withdrawing the rejection. Consequently, it is not seen that there would have been a teaching to select the amide in particular, select the hindered phenol, and/or make the combination as proposed in the Office Action.

It is respectfully submitted, for instance, that the rejection over the combination of JP 46-278874 in view of JP 06-93070 merits reconsideration and withdrawal. First, the primary reference does not teach a combination of an amide compound of Applicants' formula (I) in combination with a hindered phenol defined by formula (II) or formula (III). Second, the Office Action states that the "primary reference is silent regarding the use of hindered phenol compounds." Office Action, page 4. *See, e.g., Ex parte Browne*, 19 USPQ2d 1609, 1612 (BOPI 1990) ("since the prior art is silent as to this feature, we are unable to sustain the rejection which we originally precipitated."). Third, the secondary reference - at least the English language abstract - apparently refers to a single species of a phenol like compound. It does not appear to describe nor would it have suggested, for instance, a hindered phenol compound of formula (III) in which n is 1, 2 and/or 3, or in which Y has 2 or more carbon atoms. (*See*, specification, page 7, lines 6-14). Fourth, the secondary reference appears to refer to a molded product obtained by first making a mixture of specific polyisocyanate compound - a preliminary polymer according to the Abstract - and a specific oxidation stabilizer which is later combined with the polyurethane to obtain a molded product said to be "stable in modification moldability and excellent in heat resistance..." The secondary reference - at least the English Abstract - says nothing about combining the specific oxidation stabilizer with any other ingredient to make a color-fast product or to produce a product from which the stabilizers confer resistance against yellowing in nitrogen oxide environments etc. or to produce a product from which the stabilizers will not leach or have

reduced propensity to leach. Finding one element in a reference - whether it is mentioned in either the primary or the secondary reference, would not have suggested slicing the one element from a reference and combining it with other ingredients not disclosed in the other of the two references to arrive at the present claimed invention.

The Examiner apparently also opines that the ingredients that may be incorporated in the present composition would have been obvious based on alleged general knowledge in the art or because individually the ingredients may be known.¹ The alleged general knowledge would not have provided any direction to the ingredients herein, nor to their being compounded in a polyurethane to obtain a polymer composition from which such ingredients would not be expected to leach or would confer upon the composition satisfactory resistance against yellowing in an atmosphere containing oxides of nitrogen. It is respectfully noted that the Federal Circuit reversed rejections in In re Deul 34 USPQ (BNA) 1210 (Fed. Cir. 1995):

Thus, even if, as the examiner stated, the existence of general cloning techniques, coupled with knowledge of a protein's structure, might have provided motivation to prepare a cDNA or made it obvious to prepare a cDNA, that does not necessarily make obvious a particular claimed cDNA. "Obvious to try" has long been held not to constitute obviousness. In re O'Farrell , 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. Thus, Maniatis's teachings, even in combination with Bohlen, fail to suggest the claimed invention.

Similarly, here it is respectfully suggested that the unusually broad over-generalizations asserted in the present Office Action would not have made obvious the particular results obtained by Applicants, nor do they focus on the problem addressed and solved by Applicants.

¹ Identifying individual elements of an invention is various items of prior art does not establish a *prima facie* case.


Appln. No. 09/529,717
Amdt. dated December 23, 2003
Reply to Office Action of July 1, 2003

If the Examiner has any questions, please contact the undersigned.

Meanwhile, Applicants earnestly but respectfully submit that their application is now in condition for allowance.

Respectfully submitted,

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PAT. NO.	Title
1 6,615,406	Apparatus for use in the manufacture of a computer system
2 6,615,403	Compare speculation in software-pipelined loops
3 6,615,397	Optimal clock timing schedule for an integrated circuit
4 6,615,389	Database for designing integrated circuit device, and method for designing integrated circuit device
5 6,615,375	Method and apparatus for tolerating unrecoverable errors in a multi-processor data processing system
6 6,615,367	Method and apparatus for diagnosing difficult to diagnose faults in a complex system
7 6,615,360	Method and system for controlling a power on sequence in response to monitoring respective components of a computer system with multiple CPU sockets to determine proper functionality
8 6,615,346	System providing switching means on print setup preview screen thereby switching to another preview screen corresponding to another set sheet, altering settings
9 6,615,330	Virtual worm method and system
10 6,615,326	Methods and structure for sequencing of activation commands in a high-performance DDR SDRAM memory controller
11 6,615,300	Fast look-up of indirect branch destination in a dynamic translation system
12 6,615,265	Enabling planned outages of application servers
13 6,615,258	Integrated customer interface for web based data management
14 6,615,253	Efficient server side data retrieval for execution of client side applications
15 6,615,242	Automatic uniform resource locator-based message filter
16 6,615,231	System and method for directing requests to specific processing